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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,036	08/18/2003	Edwin G. Theriault	PTK-228	3243
21323	7590	06/15/2004	EXAMINER	
TESTA, HURWITZ & THIBEAULT, LLP HIGH STREET TOWER 125 HIGH STREET BOSTON, MA 02110			COMPTON, ERIC B	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,036

Applicant(s)

THERIAULT ET AL.

Examiner

Eric B. Compton

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10 and 14-17 is/are rejected.
- 7) ☒ Claim(s) 6-8 and 11-13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/18/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-4, 9-10, and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 5,224,423 to Borel.

Borel discloses a method and apparatus for mounting a printing plate (P) on a cylinder (Pp) comprising: establishing a temperature difference between the plate and the cylinder, exceeding the temperature of the cylinder (col. 2, lines 8-10); and wrapping the plate around the cylinder, the temperature difference causing the plate to shrink against the cylinder (col. 4, lines 20-21).

Note: the slots and pins (see col. 5, lines 12-20) are equivalents of the clamps, and pins of Applicant's fastening mean, since they wedge together to clamp the plate onto the cylinder.

See Figure 2 and supporting disclosure for further details.

3. Claims 1, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 2,219,085 to Watson.

Watson discloses a method and apparatus for mounting a printing plate (4) on a cylinder (2) comprising: establishing a temperature difference between the plate and the cylinder, exceeding the temperature of the cylinder, by cooling (page 2, col. 1, lines 8-

11); and wrapping the plate around the cylinder and attaching the ends by welds, the temperature difference causing the plate to shrink against the cylinder.

"The welds exert, *on cooling, the tension desired to draw said integral covering into intimate relation with said body member.*" Page 2, Col. 2, lines 65-67 (emphasis added).

See Figures and supporting disclosure for further details.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borel.

Broel discloses the invention cited above. However, they do not explicitly disclose that the temperature difference is at least 3 °C.

Regarding claims 2 and 14, "[g]enerally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. [W]here the general conditions of a claim are disclosed in the prior art, it is not inventive

to discover the optimum or workable ranges by routine experimentation.' *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40C and 80C and an acid concentration between 25 and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100C and an acid concentration of 10%.)." MPEP § 2144.05.

6. Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Borel in view of U.S. Pat. 4,025,751 to Wright.

Borel discloses the invention cited above, in particular that the temperature difference is established by heating the printing plate above that of the cylinder. However, the reference does not disclose the temperature difference is established by cooling means.

Wright discloses a method of forming a roller by forming a secure fit between a core and outer cylindrical member by a temperature difference where either the outer member is heated or the core is chilled. Therefore, the reference teaches providing a temperature difference that is established by cooling the cylinder with respect to the plate. Col. 2, lines 20-27.

Regarding claim 17, it would have been obvious to one having ordinary skill in the art to have established the temperature difference by cooling the cylinder of Borel, in light of the teachings of Wright, since "the prior art element performs the function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. *Lockheed*

Aircraft Corp. v. United States, 193 USPQ 449, 461 (Ct. Cl. 1977).” MPEP § 2184 (establishing a prima facie case of equivalence).

Allowable Subject Matter

7. Claims 6-8 and 11-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a method (or apparatus) for mounting a printing plate on a cylinder, wherein “the plate is drawn from a roll disposed within the interior of the cylinder and advanced around an exterior surface of the cylinder,” by establishing a temperature difference between the plate and cylinder, which causes the plate to shrink against the cylinder when the plate is wrapped on the cylinder, in combination with the other claimed subject matter.

Borel, above, teaches the invention merely for a plate having hooked ends. There is no teaching or suggestion to use the invention for the type of cylinder claimed by Applicant. In fact, Borel seems to teach away from such structure as being overly complex. See Col. 1, lines 55-59.

Prior Art References

The prior art references listed on the enclosed PTO-892, but not used in a rejection of the claims, are cited for their teachings of wrapping printing plates on cylinders.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (703) 305-0240. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter B. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Eric Compton
Patent Examiner
AU 3726

A handwritten signature in black ink, appearing to read "Eric Compton", with a stylized flourish at the end.